

REMARKS

This Letter and Response to Final Rejection is respectfully submitted in order to transmit the attached Request for Continued Prosecution, copy of Petition to Change Inventorship filed in parent application Serial No. 09/206,249 and the accompanying Assignment and Supplemental Declaration. This paper also addresses the Final Rejection of August 12, 2004. Also filed concurrently herewith is a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

Applicants respectfully amend the Specification of the above-captioned patent application in order to correct the claim of benefit of priority to Provisional Patent Application No. 60/069,797 filed December 16, 1997. This claim of priority was inadvertently omitted in the original Declaration and was only discovered upon recent review of the application file. Applicants also respectfully submit herewith a copy of the Supplemental Declaration filed in the parent application Serial No. 09/20,249 which both reflects the proper inventorship and amends the Declaration to reflect the relationship between the above-identified patent application and Provisional Patent Application No. 60/069,797, filed December 16, 1997, which was inadvertently omitted from the original declaration. Applicants respectfully request that the claim of the benefit of priority from Provisional Patent Application No. 60/069,797 be granted.

Applicants also respectfully submit that the inventorship of the above-identified patent application inadvertently omitted Dr. Michael Costanzo when the application was originally filed. The remaining inventors are in agreement with adding Dr. Costanzo to the inventorship, as evidenced by the attached copy of a Petition to Change Inventorship and Supplemental Declaration.

The accompanying Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) is respectfully submitted with respect to the discovery that the time for response and/or or filing an Appeal Brief had passed due to an omission in docketing the due date for this time period. Applicants respectfully request the grant of the accompanying Petition.

The Final Rejection of August 12, 2004 provisionally rejected claims 24, 28-30, 38, 40 and 44-46 under 35 U.S.C. 102(e) as being anticipated by copending Application Serial No. 09/110,409. The basis for this provisional rejection is that Serial No. 09/110,409 "discloses the

composition of STI...and a cosmetically acceptable carrier/vehicle and discloses an method of using the composition which inherently will decrease phagocytosis of ICAM-1 expression in a mammalian cell as in the instant application.” [Final Rejection, p. 3]

Applicants respectfully requests reconsideration of the foregoing rejection in view of the ensuing discussion. The Final Rejection states that “on page 20 of the instant specification, applicant admits that they can use the instant invention for treating what applicant is treating in 09/110,409, skin pigmentation. Thus there is no difference between the two applications.” [Final Rejection, p. 3]. Applicants respectfully suggest that the statute requires that, in order to be an anticipatory reference, the cited reference itself should disclose the claimed invention. Applicants respectfully submit that the Final Rejection is quoting the **instant** specification, which was filed **after** Serial No. 09/110,409, **not** the earlier application—the earlier application nowhere indicates or recognizes the method of use set forth in the claims of the instant application. Applicants respectfully submit that, again, this rejection is premature and should be held in abeyance until claims of 09/110,409 are issued in a patent. Applicants respectfully submit that they could not present claims corresponding to those of the instant application in the other copending application in light of the fact that the claims of the instant application would require basis in the Specification for treating or preventing disorders ameliorated by decreasing phagocytosis or ICAM-1 expression. Applicants respectfully request reconsideration of the foregoing provisional rejection under 35 U.S.C. 102(e).

The Office Action of August 12, 2004, again rejected claims 24, 28-30, 38, 40, and 44-46 under 35 U.S.C. §102(b) as being anticipated by Holmgren et al. (col. 17), Hammonds, Jr. et al. (col. 36) and Hammonds, Jr. et al. (col. 37) on the ground that although applicants argued that the references “do not administer STI to a patient as claimed, but as claimed, the patient could have any condition.” [Final Rejection, p. 4]. Applicants respectfully request reconsideration of this rejection in view of the ensuing discussion.

Applicants respectfully submit that, as claimed, the method of their invention requires that the patient is **in need of** a decrease of phagocytosis or ICAM-1 expression. Thus, the patient could not “have **any** condition”, but a condition that requires the decrease of phagocytosis or ICAM-1 expression. Applicants respectfully submit that neither Holmgren et al. nor Hammonds, Jr. et al. would anticipate the method of their claims as set forth herein. Thus, reconsideration of the rejection under 35 U.S.C. 102(b) is respectfully requested.

The Final Rejection of August 12, 2004 further rejected claims 24, 28-30, 38, 40, and 44-46 under 35 U.S.C. § 102(e) as being anticipated by Costanzo. Applicants respectfully request reconsideration of this rejection in light of the foregoing discussion and accompanying papers.

As set forth in the foregoing discussion, both this application and its parent, Serial No. 09/206,249 inadvertently omitted reference to Provisional Patent Application Serial No. 60/069,797, filed December 16, 1997. This provisional patent application was filed prior to the filing date of the patent application on which Costanzo issued. As set forth above, applicants respectfully request correction of this inadvertent error by claiming the benefit of priority of Provisional Patent Application Serial No. 60/069,797. Applicants respectfully submit that the foregoing discussion and request address the concerns with respect to the Costanzo patent and respectfully request reconsideration of the rejection of the claims under 35 U.S.C. 102(e) in view of Costanzo.

The Office Action of January 29, 2003 also provisionally rejected claims 24, 28-30, 38, 40, 44-46 under 35 U.S.C. 101 and under the judicially created doctrine of obviousness-type double patenting over claims 1-25, 56-59 of copending Application Serial No. 09/110,409. Applicants respectfully request reconsideration of this rejection.

Applicants respectfully submit that Serial No. 09/110,409 neither suggests nor describes the methods of applicants' invention and, therefore, the claims are not coextensive in scope. Nowhere therein is there a suggestion that STI or other members of the delineated Markush group of the claims would be useful in treating or preventing disorders ameliorated by decreasing phagocytosis or ICAM-1 expression. Applicants respectfully submit that, again, this rejection is premature and should be held in abeyance until claims of 09/110,409 are issued in a patent. Applicants respectfully submit that they could not present claims corresponding to those of the instant application in the other copending application in light of the fact that the claims of the instant application would require basis in the Specification for treating or preventing disorders ameliorated by decreasing phagocytosis or ICAM-1 expression in patients in need thereof. Applicants respectfully request reconsideration of the rejections under 35 U.S.C. §101 and the judicially created doctrine of obviousness-type double patenting in view of the foregoing discussion.

Applicants respectfully request reconsideration of the above-mentioned rejections under 35 U.S.C. 102(b) and (e) in light of the foregoing amendments to the claims, the accompanying papers and the foregoing discussion.

Applicants respectfully request correction of the claim of the benefit of priority with respect to the abovementioned provisional patent application, addition of Michael Costanzo to the inventorship of the above-captioned patent application and reconsideration of the rejections set forth in the Final Rejection of August 12, 2004.

Applicants also respectfully request the grant of the accompanying Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

An early allowance is earnestly solicited.

Respectfully submitted,

By: /Andrea L. Colby/
Andrea L. Colby
(Attorney for Applicants and
Assistant Secretary,
Johnson & Johnson
Consumer Companies, Inc.)
Reg. No. 30,194

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2792
Dated: June 14, 2005



Docket No. JBP-438

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Miri Seiberg, et al.
Serial No.: 09/206,249 Art Unit: 1651
Filed : July 6, 1998 Examiner: M. Meller
For : METHOD FOR REGULATING PHAGOCYTOSIS

I hereby certify that this correspondence is being deposited with the
United States Postal Service as first class mail in an envelope addressed
to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

March 25, 2005

(Date of Deposit)

Andrea L. Colby - Reg. No. 30,194

(Name of applicant, assignee, or Registered Representative)

/Andrea L. Colby/

(Signature)

March 25, 2005

(Date of Signature)

Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION, AMENDMENT, STATEMENT OF ASSIGNEE AND FEE TO CORRECT
INVENTORSHIP UNDER 37 CFR §1.48(a)

Dear Sir:

Applicants hereby petition to correct the inventorship in
the above-identified patent application.

Please add the following inventor: Michael J. Costanzo in
the above-identified patent application.

The following documents are attached hereto:

- (1) a Statement of Facts verified by the originally named inventors establishing when the error without deceptive intention was discovered and how it occurred; and
- (2) a Declaration by each actual inventor.

Johnson & Johnson Consumer Companies, Inc., Grandview Road, Skillman, NJ 08558 hereby consents to the correction of inventorship filed herewith.

The Assignment for the above-identified patent application was submitted to the Patent and Trademark Office on May 3, 1999 (Reel No. 9933710) to Johnson & Johnson Consumer Companies, Inc., a copy of which is attached hereto.

Please charge the fee set forth in 37 CFR §1.17(h) to Deposit Account No.: 10-0750/JBP438/ALC. A triplicate copy of this sheet is attached hereto.

Respectfully submitted,

By: /Andrea L. Colby/
Andrea L. Colby
(Attorney for Applicants and
Assistant Secretary,
Johnson & Johnson
Consumer Companies, Inc.)
Reg. No. 30,194

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2792
Dated: March 25, 2005

Please type a plus sign (+) inside this box ☐

PTO/SB/01 (10-00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**DECLARATION
AND
POWER OF ATTORNEY
FOR UTILITY OR DESIGN
PATENT APPLICATION
(37 CFR 1.63)**

☐ Declaration Submitted with Initial Filing OR ☒ Declaration Submitted after Initial Filing (Surcharge (37 CFR 1.16(e)) required)

Attorney Docket Number JBP438

First Named Inventor Miri Seiberg

COMPLETE IF KNOWN

Application Number 09/206,429

Filing Date December 7, 1998

Group Art Unit 1654

Examiner Name Michael V. Meller

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

METHODS FOR REGULATING PHAGOCYTOSIS
(Title of the Invention)

the specification of which

☐ is attached hereto

OR

☒ was filed on (MM/DD/YYYY) 12/07/1998 as United States Application Number or PCT International Application Number 09/206,249 and was amended on (MM/DD/YYYY) ☐

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

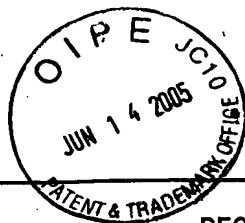
I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached? YES NO	
			<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>	<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>	<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>

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☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:



DECLARATION - Utility or Design Patent Application

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	
60/069797	12/16/1997	<input type="checkbox"/> Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

Application Serial No.	Filing Date	Status
		Patented Patented Patented

I hereby appoint:

☒ Practitioners at Customer Number **000027777** →

 Place Customer
Number Bar Code
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AND

☐ Practitioner(s) named below:
Name Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Address all telephone calls to _____ at telephone number (732) 524-_____.

 Direct all correspondence to: ☒ Customer Number **000027777** OR ☐ Correspondence address below

Name:

Address:

Address:

City:

State:

ZIP

Country

Telephone:

Fax:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR:

☐ A petition has been filed for this unsigned inventor

Given Name
(first and middle [if any]) Miri

Family Name
or Surname Seiberg

Inventor's
Signature

Date

Residence: City Princeton

State NJ

Country USA

Citizenship US and Israel

Mailing Address 168 Herrontown Road

City Princeton

State NJ

ZIP 08540

Country USA

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SECOND INVENTOR:

☐ A petition has been filed for this unsigned inventor

Given Name
(first and middle [if any]) Stanley S.

Family Name
or Surname Shapiro

Inventor's
Signature

Date

Residence: City

State NJ

Country USA

Citizenship USA

Mailing Address

City

State NJ

ZIP

Country USA

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NAME OF THIRD INVENTOR:

☐ A petition has been filed for this unsigned inventor

Given Name
(first and middle [if any]) Magdalena G.

Family Name
or Surname Eisinger

Inventor's
Signature

Date

Residence: City Demarest

State NJ

Country USA

Citizenship USA

Mailing Address 30 Pine Terrace

City Demarest

State NJ

ZIP 07627

Country USA

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF FOURTH INVENTOR:

☐ A petition has been filed for this unsigned inventor

Given Name (first and middle [if any]) Michael J.		Family Name or Surname Costanzo	
Inventor's Signature		Date:	
Residence: City Ivyland	State PA	Country USA	Citizenship USA
Mailing Address 14 Breckenridge Drive			
City Ivyland	State PA	ZIP 18974	Country USA

Please type a plus sign (+) inside this box ☐

PTO/SB/01 (10-00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**DECLARATION
AND
POWER OF ATTORNEY
FOR UTILITY OR DESIGN
PATENT APPLICATION
(37 CFR 1.63)**

☐ Declaration Submitted with Initial Filing **OR** ☒ Declaration Submitted after Initial Filing (Surcharge (37 CFR 1.16(e)) required)

Attorney Docket Number JBP438

First Named Inventor Miri Seiberg

COMPLETE IF KNOWN

Application Number 09/206,429

Filing Date December 7, 1998

Group Art Unit 1654

Examiner Name Michael V. Meller

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

METHODS FOR REGULATING PHAGOCYTOSIS
(Title of the Invention)

the specification of which

☐ is attached hereto

OR

☒ was filed on (MM/DD/YYYY) 12/07/1998 as United States Application Number or PCT International Application Number

09/206,249 and was amended on (MM/DD/YYYY) ☐

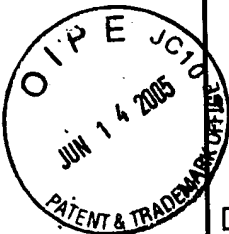
I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>	<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>	<input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/> <input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:



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DECLARATION - Utility or Design Patent Application		
I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.		
Application Number(s)	Filing Date (MM/DD/YYYY)	<input type="checkbox"/> Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.
60/069797	12/16/1997	
I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:		
Application Serial No.	Filing Date	Status
		Patented Patented Patented
I hereby appoint: <div style="display: flex; justify-content: space-between;"> <div> <input checked="" type="checkbox"/> Practitioners at Customer Number 000027777 → </div> <div style="text-align: right;"> Place Customer Number Bar Code Label Here </div> </div> <p style="margin-top: 10px; text-align: center;">AND</p> <div> <input type="checkbox"/> Practitioner(s) named below: <div style="display: flex; justify-content: space-between; margin-top: 5px;"> <div><u>Name</u></div> <div><u>Registration Number</u></div> </div> </div>		
as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.		
Address all telephone calls to _____ at telephone number (732) 524-_____.		
Direct all correspondence to: Customer Number 000027777 OR <input type="checkbox"/> Correspondence address below		
Name: _____		
Address: _____		
Address: _____		
City: _____	State: _____	ZIP: _____
Country: _____	Telephone: _____	Fax: _____

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any]) Miri		Family Name or Surname Seiberg	
Inventor's Signature		Date	
Residence: City Princeton	State NJ	Country USA	Citizenship US and Israel
Mailing Address 168 Herrontown Road			
City Princeton	State NJ	ZIP 08540	Country USA

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SECOND INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any]) Stanley S.		Family Name or Surname Shapiro	
Inventor's Signature		Date	
Residence: City	State NJ	Country USA	Citizenship USA
Mailing Address			
City	State NJ	ZIP	Country USA

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF THIRD INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any]) Magdalena G.		Family Name or Surname Eisinger	
Inventor's Signature		Date	
Residence: City Demarest	State NJ	Country USA	Citizenship USA
Mailing Address 30 Pine Terrace			
City Demarest	State NJ	ZIP 07627	Country USA

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF FOURTH INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle [if any]) Michael J.		Family Name or Surname Costanzo	
Inventor's Signature <i>Michael J. Costanzo</i>		Date: October 12, 2004	
Residence: City Ivyland	State PA	Country USA	Citizenship USA
Mailing Address 14 Breckenridge Drive			
City Ivyland	State PA	ZIP 18974	Country USA